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Docket No. P1181US00**REMARKS**

Favorable reconsideration of the present patent application is respectfully requested in view of the foregoing amendments and the following remarks.

In this Amendment claims 52, 61-62 and 71 are amended, claims 72-73 are added, and claims 60 and 70 are canceled (claims 1-51 were previously canceled). As a result, claims 52-59, 61-69 and 71-73 are now pending in the application. Independent claims 52 and 62 are amended by this paper to respectively incorporate features of dependent claims 60 and 70, now canceled. Support for the newly added claims can be found throughout the disclosure, for example, at pages 8 and 11-12 of the specification.

In the non-final Office Action of October 2, 2008, claims 56 and 66 are rejected under the written description requirement of 35 U.S.C. §112 first paragraph. Claims 62-71 are rejected under 35 U.S.C. §101 as allegedly being drawn to nonstatutory subject matter. Claims 52-71 are rejected under 35 U.S.C. §103(a) in view of U.S. Patent 6,539,548 (Hendricks '548, which incorporates by reference Hendrick's '785) further in view of U.S. Patent 5,589,892 (Knee).

§112 First Paragraph Rejection

The rejection of claims 56 and 66 under §112 first paragraph is respectfully traversed for at least the following reasons.

Claim 56 recites "removing said channel from the favorites list after the content has aired, the channel being removed without user intervention." Claim 66 recites a similar feature. The Office Action contends that the subject matter of these claims is not adequately described in the specification. It is believed these features are adequately defined in the specification to the extent

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that one of ordinary skill in the art, upon reading the specification, could make and use the invention including these features at issue. For example, the specification provides the following description of the favorite channels services 8:

[0031] The favorites services 8 manages the favorites database 12 that describes the collection of favorite channel lists and the channels that compose these lists. Favorites services 8 provides favorites list management functions, and also a set of common user interfaces for selecting a favorite item from a list, adding an item to a favorite list, and removing an item from a favorite list. Thus, an application calls favorites services 8 when it wishes to add or delete an item such as a channel from a given favorites list. The favorites services 8 provides both the functionality to maintain the favorites list, as well as the user interface to allow a user to add or delete an item from the list, name lists, rename lists, add lists and remove lists. Thus, regardless of which application calls favorites services, the interface presented to the user remains consistent.¹

In other words, the Favorites Services 8 can either provide the favorites list management functions itself ("Favorites Services 8 provides favorites list management functions"), or the Favorites Services 8 can provide interfaces for a user so the user can perform management functions of the favorites list ("and also a set of common user interfaces for selecting a favorite item from a list, adding an item to a favorite list, and removing an item from a favorite list."). The specification expressly states that the Favorites Services 8 has the functionality to maintain the favorites list: ("The favorites services 8 provides both the functionality to maintain the favorites list, as well as..."). This is distinguished from the functionality being provided to the user by way of a user interface: ("as well as the user interface to allow a user to add or delete an item from the list, name lists, rename lists, add lists and remove lists."). Hence, it is respectfully submitted that at least this passage of the specification supports "removing said channel from the favorites list ... without user intervention," as recited in claim 56 and 66.

¹ Specification, page 8 (emphasis added).

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As for the timing of the channel removal ("after the content has aired," as recited in claim 56 and 66), it is respectfully submitted that this feature is fully supported as well. The specification, for example, at pages 10-12, discusses different types of favorite channel lists including a theme-based favorite channel list and a usage-based favorite channel list. The specification explains how to search for favorite channels to include within the different types of favorite channel lists. Upon finding an upcoming program of interest that is going to air, the channel can be added to the favorite channel list and is then displayed on the EPG guide as a favorite channel. The specification goes on to explain how the favorites channels should be periodically removed from the list at least once per time slot. For example, the specification states that "[i]f the timeslots are in 30 minute increments, the system will likely want to update no less that every 30 minutes in order to maintain a consistent duration of events." Thus, the system updates the favorites list (e.g., every 30 minutes) to add new channels to the list and delete channels from the list after the content of interest has aired. Accordingly, it is respectfully submitted that the feature pertaining to timing of the favorites list updating ("after the content has aired") is disclosed at least by this passage of the specification.

Accordingly, it is respectfully submitted that the features of dependent claims 56 and 66 are described within the specification in accordance with §112 first paragraph. Therefore, withdrawal of the rejection is earnestly requested.

§101 Rejection

The §101 rejection of claims 62-71 is respectfully traversed for at least the following reasons.

The Office adopts the position that:

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Claims 62-71 recite "a computer readable medium having computer executable instructions stored thereon for execution on a computer..." does not necessarily define structural and functional interrelationships between the computer program and computer components which permit the functionality of the computer program to be realized and is thus not statutory.²

Here the Office is not alleging that the claim includes nonfunctional descriptive material. (In fact, the steps of rejected claims 62-71 do indeed contain functional descriptive material. Note the similarity to the features of the steps in claims 52-61). But rather, the Office adopts the position that the claims do not define structural and functional interrelationships between the computer program and computer components. The mere fact that functional descriptive material is claimed as being embodied in computer-readable media does not indicate nonstatutory subject matter. The prevailing law holds just the opposite—that is, functional descriptive material claimed as being embodied in computer-readable media is statutory subject matter. The MPEP states this in the following passage of the section cited in the Office Action:

In contrast, a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory.³

In the event this rejection is maintained, it is respectfully requested that the next paper from the Office point in the MPEP to support for its position that functional descriptive material stored on a computer-readable media becomes nonstatutory subject matter.

Accordingly, for at least these reasons it is respectfully submitted that claims 62-71 define statutory subject matter. Therefore, withdrawal of the §101 rejection is earnestly requested.

² Office Action of October 2, 2008, at page 3.

³ MPEP §2106.1(I).

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Docket No. P1181US00*§103 Rejection*

The §103 rejection of claims 52-71 is respectfully traversed for at least the following reasons. Independent claims 52 and 62, which are now amended to respectively incorporate features of dependent claims 60 and 70, remain subject to the pending §103(a) rejection since dependent claims 60 and 70 were also subject to the rejection.

The claimed invention involves various features of managing favorite channels through the use of a *user specified theme* rather than solely managing the favorite channels by using usage-based (or frequency based) channel selection, or through the use of user profile information or an indication of the user's mood. Claims 52 and 62 each recite, for instance, "receiving inputs from a user specifying a theme for the favorite channels" and "searching available channels for content matching the theme." By contrast, the art relied upon in the pending §103 rejection involves the use of a personal information profile for the user along with an indicator of the user's current mood. This is explained in the following passage of Hendrick's '785:

In order for the set top terminal 220 to make decisions on which programs the subscriber should watch, the terminal creates a personal profile for the particular viewer. Using the data in the particular viewer's personal profile, subscriber mood information and the television program information available in the program control information signal, the set top terminal 220 is able to select a group of programs which the particular viewer is most likely to watch.

Specifically, the set top terminal 220 builds a personal profile for each viewer and stores the information in a memory file by viewer name. To build a personal profile, the viewer answers a series of questions presented on a series of menu screens. These personal profile screens request the viewer to input information such as name, sex, age, place of birth, place of lower school education, employment type, level of education, amount of television program viewing per

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week, and the number of shows in particular categories that the viewer watches in a given week such as, sports, movies, documentaries, sitcoms, etc.⁴

Hence, as expressly stated in the Hendrick's '785 patent, the system uses "data in the particular viewer's personal profile, subscriber mood information and the television program information available in the program control information signal [to] select a group of programs which the particular viewer is most likely to watch."⁵ Therefore, the Hendricks documents do not disclose or suggest the claim features mentioned above.

The secondarily cited patent to Knee is relied upon to purportedly involve adding another channel to the favorite channel list in response to detecting a match for the theme, a feature acknowledge by the Office that is not taught or suggested by either of the Hendricks documents. However, the Knee patent does not overcome the aforementioned deficiency of the Hendricks documents. Namely, the Knee patent does not teach or suggest "receiving inputs from a user specifying a theme for the favorite channels" and "searching available channels for content matching the theme," as recited in claims 52 and 62.

Accordingly, it is respectfully submitted that the Hendricks patents and the Knee patent, either taken singly or in hypothetical combination, do not teach or suggest the features of the claimed invention. Therefore, withdrawal of the pending §103 rejection is earnestly requested.

⁴ Hendrick's '785, col. 33, line 50 to col. 34, line 8.

⁵ Hendrick's '785, col. 33, lines 61-65.

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Deposit Account Authorization / Provisional Time Extension Petition

It is believed that no additional fees or extension of time is required for this filing.

However, to the extent necessary, a provisional petition for an extension of time under 37 C.F.R. §1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this, concurrent and future replies, including extension of time fees, to Deposit Account 50-0439 and please credit any excess fees to such deposit account.

CONCLUSION

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance. However, in the event there are any unresolved issues, the Examiner is kindly invited to contact applicant's representative so that such issues may be resolved as expeditiously as possible.

Respectfully submitted,

GATEWAY, INC.

By



Date:

Dec. 29, 2008

Jeffrey A. Proehl (Reg. No. 35,987)

Customer No. 24,333

610 Gateway Dr., Y-04

N. Sioux City, SD 57049

Telephone (605) 846-2042 ext. 26809 (Lori Boulware – pat. assist.)

Fax (605) 232-2612